

IGB 1531

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: KING et al.

Group Art Unit: 1714

Serial No.: 09/631,412

Examiner: C. Shosho

Filed: August 3, 2000

Date: February 4, 2002

For: INK JET PRINTING METHOD

Assistant Commissioner for Patents
Washington, D.C. 20231**RESPONSE TO RESTRICTION ELECTION AND
AMENDMENT**

Sir:

This is responsive to the Restriction Requirement and Office Action dated August 3, 2001, in the above-identified application.

Applicants have simultaneously, under separate cover, submitted with this response a Petition under 37 C.F.R. 1.183 invoking Extraordinary Circumstances for Waiver of Extension Fees (in whole or part), or in the alternative, as a Petition for payment of extension fees for filing this response (see copy enclosed for your records).

RESPONSE TO RESTRICTION ELECTION

The Examiner has required that an election of invention be made between the following invention Groups: the recording medium of Group I (Claims 1-16) and the ink jet printing method of Group II (Claims 17-30). The invention of Group II (Claims 17-30) were provisionally elected with traverse in a telephone discussion with the Examiner on July 26, 2001. Applicants herein confirm the election of Group II, this election is traversed for the following reasons.

The Examiner asserts that the inventions of Groups I and II are distinct, as the process for using the product as claimed can be practiced with "another materially different product such as a recording medium which comprises only an ink receiving layer and no protective layer, recording medium which comprises other layers

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in addition to the ink receiving layer and protective layer such as subbing layer, adhesive layer, etc. or a recording medium which is simply paper." Applicants submit that this assertion is in error.

The invention defines a recording medium that comprises a substrate coated with at least one ink receiving layer and at least one upper protective layer having polymeric particles with film forming temperatures between 60 to 140 °C and a binder.

Claims 17-30 define the process of using the recording medium as defined in Claim 1 in an ink jet printing method. In the present invention due to the presence of the polymeric particles the protective coating layer is "non-tacky". Thus when heated a stable image-protecting coating is formed wherein the image is retained on the original support "substantially within the upper protective layer" (see Applicants specification at page 4 lines 20-23). None of the other products suggested by the Examiner would produce this result.

The Manual of Patent Examining Procedure provides that restriction between patentably distinct inventions is proper when (1) the inventions are independent or distinct as claimed, and (2) unrestricted examination would seriously burden the Examiner. See MPEP 803. Neither criteria is met in the present case. It is believed that the fields of search for the recording sheet and composition claims of the invention overlap and that Patent efficiencies will be furthered by unrestricted examination of the application.

For the foregoing reasons, Applicants request that the Examiner reconsider her decision and withdraw the restriction requirement and examine claims 1-30 together.

AMENDMENT

Responsive to the Office Action dated August 3, 2001, please amend the above-identified application as follows: